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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,114	01/29/2004	Jerry F. Sullivan	COLT 20.873 (101402-00008)	4433
26304	7590	10/17/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			GROSSO, HARRY A	
			ART UNIT	PAPER NUMBER
			3781	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,114

Applicant(s)

SULLIVAN ET AL.

Examiner

Harry A. Grosso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2006 has been entered. .

Election/Restrictions

Applicant's acknowledgement of the election of species by original presentation in the reply filed on July 25, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

The objection to claim 24 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been overcome by the amendment filed July 25, 2006. The objection is withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-18, 21, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ransom (2,420,191) in view of Ibsen et al (4,256,603).

3. Regarding claim 13, Ransom discloses a retaining device for at least two containers with a basic body (6, Figures 1-3), an accommodating opening for the containers (12, 13) and the device is designed for removal of the containers in a fixed sequence. Ransom does not teach containers filled with a material for dental restorative work. Ibsen et al discloses containers (14-18) filled with material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Ransom to use Ransom to provide a means for keeping the containers fixed in the sequence needed for use.

4. Regarding claims 14 and 17, Ransom discloses a retaining device with a slot as an accommodating opening for the containers (12, 13) and mounts (15, 16, 17, 18) for containers

5. Regarding claim 15, Ransom discloses the device is plastic (column 1, lines 27-33) that is resilient and allows the containers to be inserted and removed and held securely.

6. Regarding claim 16, Ransom discloses the device with a handle (20) that has gripping surfaces on the top, bottom and sides of the handle.

7. Regarding claim 18, Ransom discloses the device has profiles for securing the containers (15, 16, 17, 18, column 1, lines 48-55).

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8. Regarding claim 21, Ransom discloses a container arrangement having at least two containers and a retaining device where the containers can be removed in a predeterminable sequence (Figure 1). Ransom does not teach containers filled with a material for dental restorative work. Ibsen et al discloses containers (14-18) filled with material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Ransom to use Ransom to provide a means for keeping the containers fixed in the sequence needed for use.

9. Regarding claim 22, Ransom discloses the container arrangement of claim 21 and that the retaining device accommodates the containers in a form fitting manner (column 1, lines 48-55).

10. Regarding claim 24, Ransom discloses the container arrangement having at least two containers and a retaining device for accommodating and connecting the containers. Ibsen et al discloses containers (14-18) filled with material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Ransom to use Ransom to provide a means for keeping the containers fixed in the sequence needed for use.

11. Regarding claim 25, Ransom discloses a retaining device for at least two containers with a basic body of an elastic polymer material with an accommodating

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opening that can be widened for removal of a container and a first container has material for dental restorative work as discussed in the paragraphs above and the containers can only be removed in a predetermined sequence.

12. Claims 13, 14, 19, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iacono (4,037,766) in view of Ibsen et al (4,256,603).

13. Regarding claim 13, Iacono discloses a retaining device for at least two containers with a basic body (10, Figures 1-2), an accommodating opening for the containers (14, 16, 18) and the device is designed for removal of the containers in a fixed sequence. Iacono does not teach containers filled with a material for dental restorative work. Ibsen et al discloses containers (14-18) filled with material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Iacono to use Iacono to provide a means for keeping the containers fixed in the sequence needed for use.

14. Regarding claim 14, Iacono discloses a retaining device with an accommodating opening for the containers and mounts (the edges of slots 14, 26, 18) for containers.

15. Regarding claim 19, Iacono discloses a standing surface (44).

16. Regarding claim 21, Iacono discloses a container arrangement having at least two containers and a retaining device where the containers can be removed in a predeterminable sequence (Figure 1). Iacono does not teach containers filled with a material for dental restorative work. Ibsen et al discloses containers (14-18) filled with

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material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Iacono to use Iacono to provide a means for keeping the containers fixed in the sequence needed for use.

17. Regarding claim 24, Iacono discloses the container arrangement having at least two containers and a retaining device for accommodating and connecting the containers. Ibsen et al discloses containers (14-18) filled with material for dental restorative work. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen et al in the retaining device disclosed by Iacono to use Iacono to provide a means for keeping the containers fixed in the sequence needed for use.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ransom or Ibsen et al as applied to claim 13 in view of Eliassen (4,022,363). Ransom and Ibsen et al disclose the invention except for the ability to prevent preliminary opening of the containers. Eliassen discloses a retaining device for containers with a shield over the top of the accommodating opening to protect the containers and prevent opening of the containers prior to removal from the retaining device (21, Figure 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a shield over the top of the accommodating opening as disclosed by Eliassen in the retaining devices disclosed by Ransom and Ibsen et al to

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protect the containers and prevent opening of the containers prior to removal from the retaining device.

Response to Arguments

19. Applicant's arguments filed July 25, 2006 have been fully considered but they are not persuasive.

20. Applicant argues that the retaining devices of Ransom and Iacono would not be capable of holding the small containers of Ibsen and are rendered inoperable with the containers of Ibsen. In response, the retaining devices of Ransom and Iacono do not specify any container size limitations and there is nothing to prevent making them for any size container desired. Iacono indicates the slot within his device can be varied for varying size containers.

21. Applicant argues that Ransom and Iacono do not provide for removal of containers in a fixed sequence. In response, both Ransom and Iacono provide for removal of containers in each of their accommodating openings (slots) in a fixed sequence. Even though a container can be removed from a second accommodating opening before all of the containers in the first accommodating opening have been removed, this does not negate the fact that the containers in each accommodating opening are removed in a fixed sequence. This meets the limitations of the claims.

22. Applicant argues that neither Ransom nor Iacono has accommodating openings that can be widened elastically. In response, the device of Ransom is plastic that is resilient and would be elastic, widening to allow the containers to be inserted, removed and held in place (column 2, line 55 to column 3, line 5).

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23. Applicant argues that neither Ransom nor Iacono has two gripping surfaces. In response Ransom has a handle with gripping surfaces on the top, bottom and sides of the handles. This meets the limitations as claimed.

24. Applicant argues that the instant invention is "U" shaped and has profiling for securing tube-like containers while Ransom is "W" shaped and Iacono has multiple slots and Ransom and Iacono are not capable of use with the container of the present invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the "U" shaped device, the tube-like containers and the profiling for securing the containers of the instant invention) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

25. Applicant argues that Ransom does not have a standing surface. In response, Ransom is not relied upon to provide this feature. Iacono has a standing surface.

26. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

27. In response to applicant's argument that Ransom and Iacono are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the claimed device is a retaining device for at least two containers with an accommodating opening and containers fixed in a defined removal sequence. As such, Ransom and Iacono could be considered analogous art. In any event, they are reasonably pertinent to the particular problem with which the applicant is concerned.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick
Supervisory Patent Examiner
Art Unit 3781

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